Supreme Court, U.S.
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No. 02-482

IN THE

Supreme Court of the United States

DESERET BOOK COMPANY and DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

BRIEF IN OPPOSITION

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STATEMENT OF THE CASE

In an effort to create an issue worthy of review by this Court, Petitioners have overstated the record in crafting their "Question Presented." Whereas Petitioners claim the Tenth Circuit allowed a claim for copyright infringement to proceed against them despite a finding of only "minimal" copying, the record in this case clearly establishes that Petitioners' appropriation of Respondent's original expression was "substantial." Indeed, the Tenth Circuit cited several lengthy examples in its decision of verbatim copying by Petitioners.

A. Factual Background

Dr. Gene S. Jacobsen is a decorated World War II hero who survived a three and one half year ordeal in the Philippines as a prisoner of war to the Japanese. Dr. Jacobsen is a survivor of the infamous Bataan Death March. Following the war, in late 1945 and early 1946, Dr. Jacobsen recorded in long hand his personal account, among other things, of the traumatic experiences and emotions he endured and the feelings he experienced as a prisoner of war. Aplt. App. 258-59. In 1984, Dr. Jacobsen, with the help of his wife, converted his long hand recording into a 200-plus page manuscript that he entitled *Who Refused to Die*. Aplt. App. 12. Dr. Jacobsen has a federally registered copyright in his manuscript and is the owner of all rights, title, and interests in and to *Who Refused to Die*. Aplt. App. 12.

In the fall of 1994, Petitioner Dean Hughes ("Hughes") began working on a series of fictional books set in World War II. Hughes planned that a significant portion of his series would focus on the war in the Philippines. Prior to writing his first book in the planned series, Hughes received a copy

of *Who Refused to Die* from Dr. Jacobsen's son. Aplt. App. 261. Hughes read the manuscript and then contacted Dr. Jacobsen and requested that they meet to discuss the war in the Philippines. Aplt. App. 261, 314.

In December 1994, Hughes met with Dr. Jacobsen and Dr. Jacobsen's wife, Barbara, in the Jacobsen's home and discussed information about the war. Aplt. App. 261. During this meeting, Hughes informed the Jacobsen's that Petitioner Deseret Book Company ("Deseret Book") would be publishing his series. Dr. Jacobsen told Hughes that he intended to submit *Who Refused to Die* to Deseret Book for review and hoped that Deseret Book would publish *Who Refused to Die*. Aplt. App. 262. At no time during this meeting or at any other time did Hughes request or receive permission to use, copy, paraphrase, or fictionalize the material in *Who Refused to Die*, or to use Dr. Jacobsen and his experiences as the basis for a central character in Hughes' planned series. Aplt. App. 314-315.

In the fall of 1995, Dr. Jacobsen's daughter submitted a copy of *Who Refused to Die* to Deseret Book. Aplt. App. 263. Deseret Book rejected the manuscript claiming that it was not commercially viable. Aplt. App. 264. During the same time period that Deseret Book was reviewing *Who Refused to Die*, Hughes had submitted for publication through Deseret Book Volume I of his planned series, now titled *Children of the Promise*. Although Hughes, thereafter, sent a portion of the material he had written to Dr. Jacobsen, Aplt. App. 264, he did not send any material that alerted Dr. Jacobsen to Hughes' intention to copy, paraphrase, and/or fictionalize Dr. Jacobsen's copyrighted manuscript. Aplt. App. 316-17. In a short note to Hughes, Dr. Jacobsen stated that the small amount of material he had received from

Hughes made difficult to "piece together" the storyline or comprehend the overall objective of Hughes' project. Aplt. App. 316-17; App. 149. Dr. Jacobsen has testified that he is "100 percent positive" that the material Hughes sent to him did not include material later added to *Children of the Promise* taken from *Who Refused to Die*. Aplt. App. 316-17.

Petitioners assert in their Petition for Writ of Certiorari that Hughes' copying from Dr. Jacobsen's memoir was "minimal." In fact, the evidence developed in discovery demonstrates that a significant portion of the *Children of the Promise* series was taken directly from Dr. Jacobsen's copyrighted manuscript. At his deposition, Hughes testified that "many of the pages, ***sometimes whole chapters***" from the *Children of the Promise* series were taken directly from *Who Refused to Die*. Aplt. App. 319-20 (emphasis added). Hughes testified that when he was writing the *Children of the Promise* series, he would keep Dr. Jacobsen's manuscript open and in front of him so that he could draft his books directly out of Dr. Jacobsen's manuscript. Aplt. App. 320. Hughes further testified that he used "much" from Dr. Jacobsen's manuscript and that the material came "directly out of" Dr. Jacobsen's manuscript and that he "pretty well [told] the story as it existed in [Dr. Jacobsen's] journal" because he thought that using Dr. Jacobsen's story as is would be more "compelling as a part of my plot." Aplt. App. 320.

Dr. Jacobsen did not learn that Hughes was using his life story as recorded in *Who Refused to Die* in Hughes' series until after both Volumes I and II of the series had been published. Despite the fact that Hughes and Deseret Book were timely notified that Dr. Jacobsen had contacted attorneys to pursue legal action against them for copyright infringement, Hughes and Deseret Book nevertheless

subsequently completed and published additional volumes of the series. Aplt. App. 272. Dr. Jacobsen filed his Complaint against Deseret Book and Hughes in November 1999. Aplt. App. 19.

B. The Lower Courts' Proceedings

Nearly a year after Dr. Jacobsen filed his complaint and after discovery in this case was substantially complete, Petitioners filed a Motion to Dismiss with the district court on October 10, 2000, Petitioners argued that although Dr. Jacobsen alleged, and the evidence showed, that Petitioners substantially copied and fictionalized his memoir, Dr. Jacobsen had not specifically alleged that Petitioners infringed on any protectible expression. On December 4, 2000, the matter was heard before the district court. On January 11, 2001, the district court issued an Order granting Petitioner Deseret Book's Motion to Dismiss. Applying the "supersubstantial similarity" test outlined by the Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the district court held that Dr. Jacobsen's memoir was "a historical work that is not protectable under the copyright laws," and dismissed the lawsuit.

On appeal, the Tenth Circuit reversed the district court's Rule 12(b)(6) dismissal of Dr. Jacobsen's claims. The Tenth Circuit began its decision by emphasizing the fact that it was reviewing a Motion to Dismiss and stating:

> We cannot affirm the dismissal for failure to state a claim unless, after considering the complaint, *Who Refused to Die*, and the *Children of the Promise* series in the light most favorable to

> Dr. Jacobsen, it appears beyond doubt Dr. Jacobsen can prove no set of facts in support of his claim that would entitle him to relief.

Jacobsen v. Deseret Book Company, 287 F.3d 936, 942 (10th Cir. 2002). Because it ultimately concluded that numerous portions of the *Children of the Promise* series could be seen as verbatim copying of Dr. Jacobsen's original expression in *Who Refused to Die*, the Tenth Circuit reversed the district court's dismissal of Dr. Jacobsen's claims and held that a jury should be allowed to determine whether the works are substantially similar.

In reaching its conclusion, the Tenth Circuit began by stating that "the difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression," as it is undisputed that Hughes copied many of Dr. Jacobsen's experiences in *Who Refused to Die*. *Id.* Relying on the Court's decisions in *Harper & Row, Publishing Inc. v. Nation Enterprises*, 471 U.S. 539 (1985) and *Feist*, the Tenth Circuit stated the well-settled principle that "no author may copyright facts or ideas" and a copyright therefore protects "only those aspects of the work—termed expression—that display the stamp of the author's originality." *Id.*, citing *Harper & Row*, 471 U.S. at 547; *Feist*, 499 U.S. at 348. In order to prove copying of legally protectible material, the Tenth Circuit found that Dr. Jacobsen must show "substantial similarity" between the "legally protectible elements of the original work and the allegedly infringing work." *Id.* at 942-43. In turn, the Tenth Circuit held that in order to determine "substantial similarity" it must ask:

> Whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person

> would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value.

Id. at 943. With this framework established, the Tenth Circuit turned to the district court's dismissal, which it rejected on two grounds.

First, the Tenth Circuit held that the district court incorrectly applied the "supersubstantial similarity" test outlined by the Court in *Feist* to Dr. Jacobsen's memoir. The Tenth Circuit found that a court is not required to apply the supersubstantial similarity test to all fact-based works. Because fact-based works differ "as to the relative proportion of fact and fancy," it held that the "quantum of similarity required to establish infringement differs in each case." *Id.* at 944, quoting *Harper & Row*, 471 U.S. at 563. The Tenth Circuit also found that merely applying a supersubstantial similarity test to all fact-based works would ignore the differences between "sparsely embellished maps and directories" and "elegantly written biography." *Id.*, quoting *Harper & Row*, 471 U.S. at 563. Accordingly, the Tenth Circuit concluded that because *Who Refused to Die* involves more creative effort and original expression than the telephone directories at issue in *Feist*, Dr. Jacobsen could prove substantial similarity with less similarity than required with a telephone directory. *Id.*

Second, the Tenth Circuit found that the district court incorrectly focused on the ***differences*** between *Who Refused to Die* and Petitioners' *Children of the Promise* series rather than the two works' similarities. The Tenth Circuit held that "a taking may not be excused merely because it is insubstantial with respect to the infringing work." *Id.* at 945,

quoting *Harper & Row*, 471 U.S. at 565. Instead, "the question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff's work—not whether such material constitutes a substantial portion of defendant's work." *Id.*, quoting 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[A][2], at 13-46 (2001). Thus, the Tenth Circuit concluded that it must consider whether Petitioners copied a substantial portion of *Who Refused to Die*.

After rejecting the district court's analysis, the Tenth Circuit engaged in its own thorough comparison of *Who Refused to Die* with the *Children of the Promise* series. It found that Hughes obviously copied extensively from Dr. Jacobsen's original expression in *Who Refused to Die*. The Tenth Circuit stated:

> As we need not weigh the evidence, ***we make no attempt to compile an exhaustive list of protectible material*** a jury could find to have been copied. Suffice it to say ***the similarity goes beyond the bare facts*** that both works describe a World War II Army Air Corps Supply Sergeant who was captured by the Japanese, forced to march across the Bataan Peninsula, and imprisoned in various work camps.

Id. at 945 (emphasis added).

While the Tenth Circuit, which was considering the district court's grant of a motion to dismiss for failure to plead a cause of action and was not therefore required to make a complete list of every instance of copying, it did, by way of example, provide ***four*** lengthy excerpts from both works that clearly demonstrate Petitioner Hughes' copying

went well beyond the bare facts and appropriated Dr. Jacobsen's original expression.[1] Indeed, the Tenth Circuit found that in many instances Hughes copied ***verbatim*** whole passages, as opposed to a few words or phrases, from Dr. Jacobsen's memoir. *Id.* at 947-48.

The Tenth Circuit noted that certain words contained in one of the examples it provided were enclosed in quotation marks. It agreed that quotations may be freely copied "if the quotation is recorded contemporaneously or taken directly from a written source." *Id.* at 947. The Tenth Circuit held, however, that Dr. Jacobsen's words were neither. *Id.* It concluded therefore that the trier of fact could conclude that the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used. *Id.* As the Tenth Circuit noted, "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story." *Id.*

In conclusion, the Tenth Circuit examined the *Harper & Row* opinion for its instruction on the issue of verbatim copying. It found that even though the memoir at issue in *Harper & Row* was a factual work, this Court held that the defendant's verbatim copying of the memoir appropriated original expression and amounted to copyright infringement. *Id.*, citing Harper & Row, 471 U.S. at 548-49. Relying on *Harper & Row*, the Tenth Circuit concluded that the *Children of the Promise* series contains enough material for a trier of

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1. The specifics of three of these examples are found in footnotes 7-9 of the Tenth Circuit's opinion. The fourth example is found in the body of the court's opinion. Several more similar examples are found in Respondent's briefs to the Tenth Circuit.

act to find verbatim copying[2] of Dr. Jacobsen's original expression and that Dr. Jacobsen could, therefore, prove a set of facts entitling him to relief. *Id.* at 948.

Thereafter, Petitioners requested an *en banc* hearing from the Tenth Circuit. That request was unanimously denied. Petitioners now request that the Court accept certiorari in a case that has not progressed beyond a motion to dismiss. This Court should decline.

REASON FOR DENYING THE PETITION

THE COURT OF APPEALS CORRECTLY HELD ON A MOTION TO DISMISS THAT WHERE NUMEROUS PORTIONS OF AN ALLEGED INFRINGING WORK COULD BE SEEN AS VERBATIM COPYING OF THE AUTHOR'S ORIGINAL EXPRESSION IN A COPYRIGHTED HISTORICAL WORK, A JURY SHOULD BE ALLOWED TO DETERMINE WHETHER THE WORKS ARE SUBSTANTIALLY SIMILAR.

A. The Tenth Circuit's Decision Below Is Not in Tension With Prior Decisions of This Court.

Petitioners argue that the Tenth Circuit's decision is inconsistent with the general framework for copyright infringement of factual works set forth by the Court in *Harper & Row* and *Feist*. Petitioners' argument is misguided.

2. While the Tenth Circuit held that the *Children of the Promise* series contains enough material for the trier of fact to find verbatim copying, it specifically stated that nothing in its opinion would preclude the Tenth Circuit from adopting an approach in the future which recognizes that close paraphrasing of an historical work is sufficient to establish a copyright violation. *Id.* at p. 948.

An examination of the Court's holdings in *Harper & Row* and *Feist* clearly demonstrates that the Tenth Circuit's decision in this matter is entirely consistent with this Court's precedent.

Harper & Row involved a copyright infringement claim brought against the political magazine, The Nation, for publishing an article lifting excerpts from a novel written by President Ford containing his unpublished memoirs. Harper & Row owned the copyright to President Ford's memoir, which the Court characterized as "a historical narrative or autobiography." *See Harper & Row*, 471 U.S. at 563. The Nation obtained a copy of the memoir prior to its publication and published an article including verbatim quotes from the memoir.

While the Court began with the proposition that the law generally recognizes a greater need to disseminate works based on fact rather than those based on fiction, the Court recognized that substantial differences exist between different types of factual works:

> Even within the field of fact works, there are gradations as to the relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography. The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.

Id. at 563.

After examining the two works at issue in *Harper & Row*, the Court concluded that while some of the short quotes appropriated from President Ford's memoir[3] were "arguably necessary adequately to convey the facts," the "subjective descriptions" that lie in the "author's individualized expression" that were copied "exceed[ed] that necessary to disseminate the facts." *Id.* at 563-64. Thus, the Court found that The Nation had appropriated far more expression than was necessary to disseminate the underlying facts of President Ford's expressive work.

Petitioners rely heavily on the dissent in *Harper & Row*, and apparently regard Justice Brennan's analysis of the "threshold question of copyrightability" as the controlling law of the Court. Petitioner's reliance on *Harper & Row*'s dissent is misplaced. While it is true, as Petitioners point out, that the majority did not take issue with Justice Brennan's analysis of the question of copyrightability, it is important to note that the majority refused to even reach the question of copyrightability in its opinion. Indeed, Justice Brennan chided the majority for failing to conduct such an analysis. *Id.* at 580 ("The Court finds no need to resolve the threshold copyrightability issue. . . Because I disagree with the Court's fair use holding, it is necessary for me to decide the threshold copyrightability question"). The majority did not agree or disagree with Justice Brennan's analysis for the simple fact that it found such analysis unnecessary. The majority's silence cannot be taken as an approval of the dissent's analysis on the question of copyrightability as Petitioners apparently urge.

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3. For example, the Court cited President Ford's characterization of the White House tapes as the "smoking gun" as perhaps "so integral to the ideal expressed as to be inseparable from it." *Id.*

Moreover, regardless of whether Justice Brennan's dissent were viewed as controlling on the issue of copyrightability, nothing in the Tenth Circuit's decision in this case conflicts with Justice Brennan's analysis. Petitioners' summary of the dissent in *Harper & Row* is incomplete and misleading.

Justice Brennan began his opinion by noting the basic tenant that copyright protection extends to an author's literary form but precludes any claim of copyright to facts. Accordingly, he found that a claim for copyright infringement must be "based on the taking of literary form, as opposed to the ideas or information contained in a copyrighted work." *Id.* at 582. Justice Brennan stated, the test for determining whether an author's literary form has been appropriated proceeds along two axes:

> ***How closely*** has the second author tracked the first author's particular language and structure of presentation; and ***how much*** of the first author's language and structure has the second author appropriated.

Id. at 583 (emphasis in original). Justice Brennan also specified that the protection of literary form must "proscribe more than merely word-for-word appropriation of substantial portions of an author's work." *Id.* at 583 n.5. Otherwise, as Justice Brennan noted, "a plagiarist could avoid infringement by immaterial variations." *Id.*

With this framework established, Justice Brennan then compared the works at issue. Justice Brennan first examined the language used by The Nation in its article and concluded that the information "was ***not in the form of paraphrase at***

all, but took the form of ***synopsis*** of lengthy discussions in the Ford manuscript." *Id.* at 584 (emphasis added). While Justice Brennan did find that The Nation occasionally used ***sentences*** that closely resembled the language used by President Ford in his memoir, he specifically noted that:

> The Nation ***paraphrased nothing approximating the totality of a single paragraph***, much less a chapter or the work as a whole. At most The Nation paraphrased ***disparate isolated sentences*** from the original. A finding of infringement based on paraphrase generally requires far more close and substantial a tracking of the original language than occurred in this case.

Id. at 585-86, citing *Wainwright Securities Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977) (emphasis added).

Justice Brennan next examined the structure of presentation of The Nation's article and found that it did not mimic the structure of President Ford's memoir. *Id.* at 586. He, instead, determined that the information presented in The Nation's article ***did not appear in the same sequence*** as President Ford's memoir and, in fact, was drawn from ***scattered sections*** of President Ford's work. *Id.*

Based on his examination of the two works, Justice Brennan concluded that when the Nation's article was not directly quoting President Ford, the language and structure of the article did not so closely and substantially track President Ford's language as to constitute an appropriation of his literary form. *Id.* at 587.

Nothing in the Tenth Circuits opinion is inconsistent with the holding of the majority in *Harper & Row* or Justice Brennan's dissent. Petitioners argue that the Tenth Circuit's decision conflicts with *Harper & Row* because the Tenth Circuit, purportedly, "made no threshold effort to identify which components of Jacobsen's memoir constituted unprotected fact, and which constituted protected expression." Pet. Brief at p. 12. A careful reading of the opinions in *Harper & Row* demonstrates that nothing in the decision requires a court to "abstract" the unprotected facts from the protected expression of a copyrighted work as Petitioners argue. Indeed, in making his comparison of the works at issue in *Harper & Row*, Justice Brennan broadly examined the language used by The Nation to determine the extent of its verbatim copying or paraphrasing of sentences, paragraphs or chapters and then examined the overall structure of The Nation's article to determine if it tracked the same sequence as President Ford's memoir.

The Court's decision in *Harper & Row* establishes that while facts or ideas are not copyrightable, an author's "individualized expression" or the "literary form" used to describe and convey ideas or facts is protected under the copyright laws. The dissenting opinion in *Harper & Row* is in accord. Accordingly, the law proscribes verbatim copying or using "immaterial variations" of the author's original expression or literary form.

The Tenth Circuit's decision is consistent with controlling precedent. The Tenth Circuit found evidence demonstrating that Hughes copied verbatim significant portions of Dr. Jacobsen's individualized expression of his life experiences in *Who Refused to Die*. Moreover, it specifically rejected the claim that Hughes merely copied a

few words or phrases. To the contrary, it found that Hughes copied entire passages and portions of Dr. Jacobsen's memoir. The Tenth Circuit's decision is not in conflict with *Harper & Row*.

Petitioners also claim that the Tenth Circuit's decision is contrary to the Court's decision in *Feist*. Petitioners argue that *Feist* establishes that in the context of all factual works, only verbatim (i.e. use of the "precise words") copying of the author's original expression gives rise to a claim of copyright infringement. Thus, according to Petitioners, copyright protection for all factual works is "thin." Petitioners essentially argue that there is no difference in the amount of original expression in a historical work such as Dr. Jacobsen's memoir than what exists in the telephone directory at issue in *Feist*.

Feist involved a copyright infringement action by a telephone utility against a telephone directory that used listings from the utility's white pages in its publication. The Court began its opinion by noting that facts, because they are neither "discovered" nor "created", do not constitute an act of authorship, and are therefore ineligible for copyright protection. *Feist*, 499 U.S. at 347. On the other hand, factual compilations "may possess the requisite originality . . . [because] [t]he compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers." *Id.* at 348. Therefore, the Court concluded that choices as to selection and arrangement of data, so long as they are sufficiently creative, may be protected by the copyright laws. *Id.*

The Court noted, however, that the copyright in a compilation is not all-inclusive as protection extends only to the author's original expression or contribution. The *Feist* decision emphasized that "the copyright in a factual compilation is thin." *Id.* at 349. Accordingly, a "subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement." *Id.*

Examining the telephone directory at issue, this Court concluded that it was not copyrightable. Neither the facts in the directory nor their selection and arrangement met the standards of copyrightability the Court had established. The Court first held that the listings of the names, towns, and telephone numbers were pre-existing, unoriginal and therefore uncopyrightable facts. *Id.* at 361. The Court next looked at the selection of the facts in the directory and concluded that it too failed to satisfy the requirements of originality. The Court found that the telephone utility had selected and published "the most basic information—name, town, and telephone number—about each person who applies to it for telephone service." *Id.* at 362. While useful, the Court held that the utility's "selection of listings could not be more obvious," and thus fell short of meeting the minimal level of creativity. *Id.* Moreover, the Court determined that since the utility was required to publish such listings as part of its monopoly over local phone service, the utility "did not truly 'select' to publish" the listings it included in its telephone directory. Instead, the selection "was dictated by state law, not by [the utility]." *Id.* at 363.

The Tenth Circuit, consistent with the precedent of this Court, refused to apply a supersubstantial similarity test to

all fact-based works. Citing *Harper & Row*, it held that because fact-based works differ as to the amount of original or creative expression they contain, "the quantum of similarity required to establish infringement differs in each case." *Jacobsen*, 287 F.3d at 944, citing *Harper & Row*, 471 U.S. at 563. Accordingly, the Tenth Circuit concluded that Dr. Jacobsen could prove substantial similarity with less similarity than required in a case involving a telephone directory. The Tenth Circuit's holding is not inconsistent with *Feist* and is entirely consistent with *Harper & Row* on this issue.

Petitioners read *Feist* to require a court to make a threshold effort to "abstract" the unprotected facts or ideas from a copyrighted work. Because a telephone directory such as that at issue in *Feist* is made up entirely of facts, which in and of themselves are not copyrightable, the abstraction of all the unprotected elements of a factual compilation would require removing all elements of the copyrighted work. Rather than reaching this nonsensical result, the Court in *Feist* looked broadly at the arrangement and selection of the unprotected facts to determine what elements of the copyrighted work were protected. Consistent with *Feist*, the Tenth Circuit examined the two works at issue to determine whether the *Children of the Promise* series was "so similar" to Dr. Jacobsen's memoir that it could reasonably conclude that Hughes unlawfully appropriated Dr. Jacobsen's protected expression. Because it found that Hughes had copied verbatim entire passages and portions of *Who Refused to Die*, the Tenth Circuit held that there was sufficient evidence that a jury should be allowed to determine whether the works are substantially similar. The Tenth Circuit's decision to not first "abstract" all unprotected elements of *Who Refused to Die* is consistent with *Feist*.

Because the Tenth Circuit's decision in not in conflict with either, and, in fact, is entirely consistent with both, the Court's decisions in *Harper & Row* and *Feist*, Petitioners' petition for writ of *certiorari* should be denied.

B. The Tenth Circuit's Decision Is Consistent With Decisions Of The Ninth Circuit And Other Circuits.

Petitioners argue that the Tenth Circuit's decision in this matter is in direct conflict with the decisions of other circuits. In fact, the Tenth Circuit's decision is consistent with the decisions of other circuits that have dealt with the issue of the copyrightability of factual works.

Initially, it should be noted that Petitioners' primary argument, that the Tenth Circuit's decision held that a claim for copyright infringement claim involving a historical, factual work "may proceed" even "where the appropriation of expressive elements (if any) is incidental," is a straw man. In fact, the Tenth Circuit made no such limited holding. The Tenth Circuit provided several examples demonstrating the type of wrongful appropriation conducted by Hughes in writing the *Children of the Promise* series. The Tenth Circuit specifically stated that it was not necessary to its decision to provide an exhaustive list of all the protected material of Dr. Jacobsen's memoir that a jury could find to have been appropriated by Hughes. *Jacobsen*, F.3d 287 at 945. It is disingenuous for Petitioners to argue that the example provided by the Tenth Circuit in the body of its opinion is the sole incident of copying it found when comparing the works at issue in this case.[4]

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4. As noted above, the Tenth Circuit cites several other examples of verbatim copying in footnotes in its opinion. Additionally, Dr. Jacobsen in his Complaint and briefs submitted to the lower courts cites several lengthy examples of essentially verbatim copying.

Petitioners argue that the Tenth Circuit opinion is in direct conflict with the Ninth Circuit's decision in *Narell v. Freeman*, 872 F.2d 907 (9th Cir. 1989). Petitioners are mistaken. As the Tenth Circuit correctly held, the facts of the present action are readily distinguishable from those at issue in *Narell*.

In *Narell*, the Ninth Circuit held that the copying of numerous isolated phrases did not constitute infringement. The copyrighted work at issue was a nonfictional work describing the history of Jews in the San Francisco Bay Area. The defendant admitted in deposition that she had copied both historical facts and "language" from the copyrighted work. In affirming summary judgment in favor of the defendant, the Ninth Circuit held that nothing that was copied constituted protected expression.

Key to the Ninth Circuit's holding was its finding that the defendant merely copied ordinary isolated phrases and did not take a "***sequence of creative expression***" from plaintiff's copyrighted work. *Id.* at 911, quoting *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1990). The distinction between "an ordinary phrase" and a "sequence of creative expression" was explained by the Second Circuit in *Salinger* as follows:

> Though a cliché or an "ordinary" word-combination by itself will frequently fail to demonstrate even the minimum level of creativity necessary for copyright protection, such protection is available for the "association, presentation, and combination of the ideas and thought which go to make up the [author's] literary composition." Or as we have more recently stated, "What is

> protected is the manner of expression, the author's analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words and the emphasis he gives to particular developments." The "ordinary" phrase may enjoy no protection as such, but its use in a sequence of expressive words does not cause the entire passage to lose protection. And though the "ordinary" phrase may be quoted without fear of infringement, a copier may not quote or paraphrase the sequence of creative expression that includes such a phrase.

Id. at 98 (internal citations omitted).

This approach is consistent with this Court's decision in *Fiest*, which made quite clear that a compilation of non-protectible elements can enjoy copyright protection even though its constituent elements do not. In *Apple Computer, Inc. v. Microsoft Corp.*, 779 F. Supp. 133 (N.D. Cal. 1991), the district court explained this approach another way:

> Suppose defendant copied plaintiff's abstract painting composed entirely of geometric forms arranged in an original pattern. The alleged infringer could argue that each expressive element (i.e., the geometric forms) is unprotectible under the functionality, merger, scenes a faire, and unoriginality theories and, thus, all elements should be excluded prior to the substantial similarity of expression analysis. Then, there would be nothing left for purposes of determining substantial similarity of expression. In this example, elimination of "unprotectible" elements

> would result in a finding of no copyright infringement, which would be clearly inconsistent with the copyright law's purpose of providing incentives to authors of original works.

Id. at 136.

Petitioners allege that Hughes merely copied "isolated phrases" from Dr. Jacobsen's memoir. *See* Pet. Brief at p. 14. As shown above, Petitioners misstate the record. They argue because Hughes in some instances did not copy the entire quotation but rather copied such "commonplace" phrases as "use any means," "get paid for your troubles," and "get off the ship," Hughes copying is not actionable. As demonstrated above, *Narell* does not support Petitioners' argument. If Hughes had merely copied these "commonplace" phrases in isolation from one another, Dr. Jacobsen likely would have no claim. A reading of the example provided by the Tenth Circuit clearly demonstrates, however, that the phrases were not, as Petitioners allege, copied by Hughes in isolation. Hughes copied each of the phrases in sequence to one another and therefore appropriated Dr. Jacobsen's creative expression. The Tenth Circuit's reading of *Narell* is entirely consistent with the holding of the Ninth Circuit.

Petitioners next argue that the Tenth Circuit's decision conflicts with the Second Circuit's decisions in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966) and *Hoehling v. Univeral City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980). Petitioners rely on *Rosemount Enterprises* for its finding that a book which copied two direct quotations and one eight-line paraphrase from three articles about the life of Howard Hughes doubtfully constituted a substantial part of either of the articles or of the book.

Apparently, the inference that Petitioners urge the Court to draw from the *Rosemount Enterprises* decision is that the example provided by the Tenth Circuit in its opinion is insufficient to demonstrate that the material Hughes appropriated from *Who Refused to Die* constitutes a substantial part of either the *Children of the Promise* series or *Who Refused to Die*. Petitioners' reliance on *Rosemount Enterprises* is misplaced. Nowhere in its decision does the Tenth Circuit state that the example it provides is the sole instance of copying by Hughes of Dr. Jacobsen's memoir. Again, the undisputed evidence from Hughes' own deposition in this case clearly establishes that Hughes copied a significant portion of *Who Refused to Die*, including "whole chapters." As Deseret Book admits, Hughes took the "best stories" from Dr. Jacobsen's manuscript. Moreover, as the Tenth Circuit noted in its decision, "a taking may not be excused merely because it is insubstantial with respect to the *infringing* work." *Jacobsen*, 287 F.3d at 945, quoting *Harper & Row*, 471 U.S. at 565. It is irrelevant that the material Hughes copied from *Who Refused to Die* may have constituted an unsubstantial portion of the entire *Children of the Promise* series. The Tenth Circuit's decision does not conflict with *Rosemount Enterprises*.

Petitioners correctly note that the Second Circuit held in *Hoehling* that while facts are not copyrightable, the "author's original expression of particular facts" is. *Hoehling*, 618 F.2d at 974. The Second Circuit also held in *Hoehling* that "verbatim reproduction of another work . . . even in the realm of nonfiction, is actionable as copyright infringement." *Id.* at 980. Accordingly, the Second Circuit held that only "***random*** duplications of phrases and sequences of events" are not copyrightable. *Id.* at 979 (emphasis added).

The Tenth Circuit's decision is entirely consistent with *Hoehling*. The Tenth Circuit found that Hughes copied Dr. Jacobsen's original expression of particular facts verbatim. At a minimum, there were sufficient allegations of such copying to overcome the motion to dismiss. As noted in the discussion regarding *Narell* above, Hughes copying of phrases and sequences of events from Dr. Jacobsen's memoir were not found by the Tenth Circuit to be either isolated or random. The Tenth Circuit found evidence that Hughes appropriated sequences of Dr. Jacobsen's creative expression.

Petitioners ignore the Second Circuit's decision in *Salinger*, which was made several years after both *Hoehling* and *Rosemont Enterprises* and which specifically and thoroughly discusses the issue of the copyrightability of factual works. In *Salinger*, the plaintiff J.D. Salinger, who wrote *Catcher in the Rye*, brought a copyright infringement claim against the publisher of an unauthorized biography of Salinger and its author, Hamilton. Important sources of material for the biography were several unpublished letters Salinger wrote to his friends. Salinger received an initial version of the biography and demanded that quotations of his unpublished letters that appeared in the version be deleted. The biography was published with much of the material previously quoted from Salinger's unpublished letters replaced by paraphrasing. The district court found against *Salinger*.

On appeal, the Second Circuit reversed the district court's finding that the extent of copying of expressive material entitled to copyright protection was "minimal." The district court had based its holding on its finding that Hamilton's copying of Salinger's letters was fragmented and that

Hamilton merely "employ[ed] a cliché or a word-combination that is so ordinary that it does not qualify for the copyright law's protection." *Id.* at 98. Applying the law quoted above, the Second Circuit disagreed and held:

> In almost all of those instances where the quoted or paraphrased passages from Salinger's letters contain an "ordinary" phrase, the passage as a whole displays a sufficient degree of creativity as to sequence of thoughts, choice of words, emphasis, and arrangement to satisfy the minimal threshold of required creativity. And in all of the instances where that minimum threshold is met, the Hamilton paraphrasing tracks the original so closely as to constitute infringement.

Id.

The Second Circuit's holding in *Salinger* is consistent with *Narell* and *Hoehling*. Unlike those cases where the allegedly infringing work's author was found to have merely borrowed random, isolated, "ordinary" phrases, the Second Circuit found in *Salinger* that the infringing author copying the original author's sequence of creative expression. The Tenth Circuit's decision in this case is consistent with *Salinger*. The Tenth Circuit found that the evidence demonstrates that Petitioners copied more than a few words or isolated phrases from Dr. Jacobsen's memoir. Rather, Hughes copied verbatim entire passages from *Who Refused to Die*. *Jacobsen*, 287 F.3d at 97.

Finally, Petitioners argue that the Tenth Circuit's decision is in conflict with the Seventh Circuit's decision in *Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990). Petitioners cite

Nash for its holding that the allegedly infringing author's merely used the original work "as a source of facts and ideas, to which they added their distinctive overlay." *Id.* at 1543. Petitioner's admit, however, that *Nash* involved a claim for the alleged appropriation of a plot line only. There was no evidence presented to the Court of any amount of verbatim copying. Petitioners' reliance on *Nash* is misplaced. Petitioners can point to nothing in the Seventh Circuit's opinion that is in conflict with the Tenth Circuit's decision in this case.

Petitioners conclude their argument by making the following statement: "All of these cases establish that an author is permitted to engage in incidental appropriation of expressive elements from a historical, factual work." Pet. Brief at p. 16. Petitioners' statement is not supported by the holdings of any of the cases upon which they rely. The cases cited by Petitioners uniformly hold that while facts are not copyrightable, the author's original expression of those facts is entitled to copyright protection. *Hoehling* and *Narell* do state that random, isolated "ordinary" phrases are not entitled to copyright protection. As *Salinger* clearly establishes, however, the combination of even "ordinary phrases" in a "sequence of creative expression" constitutes original expression that is entitled to copyright protection. Here, Hughes' appropriation was much more than "incidental." The Tenth Circuit's decision found evidence that Petitioners copied more than a few words or phrases and instead copied verbatim passages containing Dr. Jacobsen's original expression from *Who Refused to Die*. The Tenth Circuit's decision in not in conflict with the cases cited by Petitioners. Petitioners petition should therefore be denied.

C. The Question Presented Is Not A Recurring One of Exceptional Importance.

As demonstrated above, the question presented by Petitioners for their request for certiorari is not a recurring question on which there is any disagreement among circuits that merits this Court's attention. The Tenth Circuit's decision is consistent with this Court's precedent and the decisions of the other circuits that have addressed the issue of the copyrightability of historical works.

Moreover, this case has not progressed to trial and final judgment. The Tenth Circuit's decision recognized the preliminary nature of this action and correctly held that the *Children of the Promise* series contains enough material for a trier of act to find verbatim copying of Dr. Jacobsen's original expression and that Dr. Jacobsen could, therefore, prove a set of facts entitling him to relief. Accordingly, a jury should be allowed to determine whether the works at issue are substantially similar.

The question presented by Petitioners in their Petition for Writ ignores the fact that examples provided by the Tenth Circuit were not an exhaustive list and merely constituted a threshold finding that reflected the preliminary nature of the case. The question is not of exceptional importance. The Court should therefore decline to accept certiorari.

CONCLUSION

For the foregoing reasons, this Court should deny the petition for a writ of certiorari.

Respectfully submitted,

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